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In the Supreme Court

OF THE

United States

OCTOBER TERM, 1979

No. 79-1112

SIDNEY A. DIAMOND, COMMISSIONER OF PATENTS AND TRADEMARKS,
Petitioner,

vs.

JAMES R. DIEHR, II, and THEODORE A. LUTTON
Respondents.

BRIEF IN OPPOSITION TO A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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Respondents oppose the grant of a writ of certiorari to review the unanimous judgment of the United States Court of Customs and Patent Appeals in this case.

Respondents have no disagreement with the Petition as to the citation of the opinion below, its reproduction in the appendix to the Petition, the jurisdiction, or the statute involved (35 U.S.C. § 101) and its reproduction in the Petition.

QUESTION PRESENTED

The "Question Presented" by Petitioner is not even involved in this case. It is far from what is involved, and is so inaccurate and so improper that it becomes necessary to present the following counterstatement, which is substan-

tially what the CCPA found (see second sentence of the section headed OPINION):

Does a patent process claim drawn to subject matter which is otherwise statutory become nonstatutory merely because a computer is involved in execution of a portion of the process?

As specifically applied to the facts herein, the issue becomes whether a claim to a process for molding precision rubber products, normally considered as a process within the terms of 35 U.S.C. § 101, becomes unpatentable because a programmed computer is used to determine the time when a cure is complete and the mold is opened.

STATEMENT OF FACTS

The statement of facts in the Petition is only partly correct. Most importantly and contrary to the Petition, it should be clearly understood that this invention does not involve any attempt to patent an algorithm, an equation, or any form of mathematics nor any means, computer included, of performing calculations pursuant thereto.

The invention is a process and relates directly to the molding of synthetic rubber into precision products. The molding process is performed under heat and pressure and includes curing rubber in the mold so that the product will retain its shape and be functionally operative after the molding is completed.

The claimed technology is chemical and mechanical, not mathematical. However, in all processes involving cure of synthetic rubber, the cure time must be determined. This

may be done by guesswork, or it may be calculated by means of an old, well-known equation[1] on the basis of the temperature of the mold. The trouble is that the temperature inside the mold varies appreciably, so that there is no one "temperature of the mold" on which a single calculation may be based. The present invention uses the same old equation but repeatedly recalculates the cure time using frequently updated readings of the *actual* instantaneous temperature in the mold. When the recalculated cure time coincides with the actual time that the mold has been closed, the mold is opened automatically.

This method of manufacturing precision molded articles from uncured synthetic rubber is set forth in claim 11, which is a representative broad claim:

> 11. A method of manufacturing precision molded articles from selected synthetic rubber compounds in an openable rubber molding press having at least one heated precision mold, comprising:
>
> (a) heating said mold to a temperature range approximating a predetermined rubber curing temperature,
>
> (b) installing prepared unmolded synthetic rubber of a known compound in a molding cavity of predetermined geometry as defined by said mold,
>
> (c) closing said press to mold said rubber to occupy said cavity in conformance with the contour of said mold and to cure said rubber by transfer of heat thereto from said mold,

---

[1]The equation is known as the Arrhenius equation, after its discoverer Svante Arrhenius (1859-1927) who received the Nobel prize for chemistry in 1903.

(d) initiating an interval timer upon the closure of said press for monitoring the elapsed time of said closure,

(e) heating said mold during said closure to maintain the temperature thereof within said range approximating said rubber curing temperature,

(f) constantly determining the temperature of said mold at a location closely adjacent said cavity thereof throughout closure of said press,

(g) repetitively calculating at frequent periodic intervals throughout closure of said press the Arrhenius equation for reaction time of said rubber to determine total required cure time v as follows:

$$\ln v = cz + x$$

wherein c is an activation energy constant determined for said rubber being molded and cured in said press, z is the temperature of said mold at the time of each calculation of said Arrhenius equation, and X is a constant which is a function of said predetermined geometry of said mold,

(h) for each repetition of calculation of said Arrhenius equation herein, comparing the resultant calculated total required cure time with the monitored elapsed time measured by said interval timer,

(i) opening said press when a said comparison of calculated total required cure time and monitored elapsed time indicated equivalence, and

(j) removing from said mold the resultant precision molded and cured rubber article.

Note that claim 11 has only one calculation step out of its ten steps.

The application also relates to a method for operating a rubber molding press, as stated in claim 1, which is also a representative broad claim:

1. A method of operating a rubber-molding press for precision molded compounds with the aid of a digital computer, comprising:

providing said computer with a data base for said press including at least,

natural logarithm conversion data (ln),

the activation energy constant (C) unique to each batch of said compound being molded, and a constant (x) dependent upon the geometry of the particular mold of the press, initiating an interval timer in said computer upon the

closure of the press for monitoring the elapsed time of said closure.

constantly determining the temperature (Z) of the mold at a location closely adjacent to the mold cavity in the press during molding,

constantly providing the computer with the temperature (Z),

repetitively calculating in the computer, at frequent intervals during each cure, the Arrhenius equation for reaction time during the cure, which is

$\ln v = CZ + x$

where v is the total required cure time,

repetitively comparing in the computer at said frequent intervals during the cure each said calculation of the total required cure time calculated with the Arrhenius equation and said elapsed time, and

opening the press automatically when a said comparison indicates equivalence.

Claim 1 has one data base step and only one calculating step, among at least six steps.

Claims 11 and 1 exemplify the invention for which the patent is sought. This process invention *utilizes* (1) a molding press, (2) a heater for the molding press, (3) an interval timer, (4) a thermostat, (5) a temperature measuring device located in the mold adjacent to the mold cavity, and (6) a programmed computer. All these devices are needed to obtain the desired molded rubber product.

The claimed mechanical-chemical process involves placing uncured synthetic elastomer in the mold, forming it to a precise shape, curing it in that shape, and then removing the precision-molded and cured product from the mold. The process produces a better rubber product because the product is more accurately cured. It produces more products per unit time because it eliminates the time wasted heretofore in over-curing just to be sure that the products were cured for a long enough time. It also eliminates the waste in time and materials due to the necessity of re-making improperly cured products. Respondents' novel process has now been in use in manufacturing plants for several years and it has saved many thousands of dollars for the assignee, Federal-Mogul Corporation, while supplying the public with much better products.

The purpose of the process is to improve the quality of the molded rubber products and to increase the efficiency of their production. It does not purport to improve computers, nor does the application claim a computer program, an algorithm or a calculation.

In a strict sense, the application does not disclose a computer program, but (in order to meet the disclosure requirements of 35 U.S.C. § 112) the application contains flow sheets from which a competent programmer can set up a program tailored to the particular computer which a user may select. The exact program used and the identity of the computer selected are immaterial to the invention.

No exception is taken to the Petitioner's statements about the actions by the patent examiner and the Patent and Trademark Office Board of Appeals. As to what the Court of Customs and Patent Appeals did, its own opinion is printed as Petitioner's Appendix A and speaks for itself. Note, *inter alia,* that the CCPA, although regarding the novelty of the step of continually measuring the temperature in the mold cavity as irrelevant to the § 101 issue, did regard that step as novel (Petition Appendix A, p. 13a and n.5, 602 F.2d at 987, n.5).

ARGUMENT: REASONS FOR DENYING THE PETITION

1. The "Question Presented" on Page 2 of the Petition Is Not Involved in the Case

Petitioner states that the question is:

> "Whether a computer program that regulates the curing time of rubber products in a mold is patentable subject matter under 35 U.S.C. 101"

Respondents are not attempting to patent a computer program. While the CCPA stated in a footnote (Petition Appendix A. p. 5a, n.3, 602 F.2d at 984, n.3) that the applicants' flow sheet *discloses* a computer program, it never said that the *claims* were directed to a computer

program. The claims are not directed to a computer program, even in part, and the CCPA rightly concluded:

> "Each of appellants' claims, *as a whole,* recites a process or method for molding rubber articles. They are an improvement over prior processes in that appellants provide for opening the mold at precisely the correct time rather than at a time which has been determined by approximation or guesswork. It is this feature of the process that *involves* the Arrhenius equation. The recitation of the equation is not separable from the process in which it is used; it is intimately involved in the process, but the claims are not to the equation. We find these claims to be directly comparable to those involved in *Tilghman v. Proctor,*[2] supra, and *Eibel Process Co. v. Minnesota and Ontario Paper Co.,*[3] supra, in that they involve the employment of a scientific truth to a new and useful end without attempting to control the use of the truth itself. As Mr. Justice Stone, writing for the Court in *Mackay Radio and Telegraph Co. v. Radio Corporation of America,* 306 U.S. 86 (1939),[4] stated (306 U.S. at 94):
>
> > While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.
>
> "Though he spoke of structure the same is true of a process and the reasoning applies with equal force. The claims here at issue are not, as the PTO asserts, directed to an improved method of calculation for the cure time of rubber articles; such a conclusion is only made possible by ignoring the fact that a molding

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[2]102 U.S. 707 (1881).
[3]261 U.S. 45, 43 S.Ct. 322 (1922).
[4]Also 59 S.Ct. 427 (1939).

> press is recited and operates as the heart of the process." (Petition, Appendix A, 15a *et seq.* 602 F.2d at 988) (emphasis in original).

A basic error in the Petition is that Petitioner chooses to disregard the text of the *claims* in issue (and the claims *are* the issue) and attempts to force the present invention into the same form and even into the very words of Flook's claim in *Parker v. Flook,* 437 U.S. 584, 98 S. Ct. 2522, 57 L.ed.2d 451, 198 USPQ 193 (1978). Petitioner's attempt is completely improper. Respondents' invention is not like Flook's invention. Respondents' own claims are at issue here—not Respondents' claims recast by Petitioner in a Flook mold—and are what must be measured against Section 101. Petitioner cannot base its case on claims that Petitioner has written.

To grant certiorari and consequently to address an issue not actually in *this* case would only result in dicta or an advisory opinion, not in a true decision, and is contrary to Rule 19 of this Court. The actual issues are simple. They were correctly decided below and do not deserve the attention of the Supreme Court.

2. The Decision Below Is a Correct Application of the Law as Enunciated in Gottschalk v. Benson and Parker v. Flook

The Petition implies that the Court of Customs and Patent Appeals has failed to abide by this Court's prior decisions, and that it "refused to apply the analysis of patent claims required under *Parker v. Flook.*" (Petition for Certiorari, page 6). Such is not the case.

The CCPA carefully considered *Parker v. Flook, supra.* The CCPA opinion refers to *Parker v. Flook* by name on fourteen occasions—in the sections entitled "The Rejection" and "Appellants' Arguments" as well as on nearly every page in the section entitled "OPINION". After the CCPA carefully examined Diehr's application in the light of *Parker v. Flook,* it concluded that the present case did not involve claims for an improved method of calculation and that the instant claims were not directed essentially to a method of calculating:

> "It would be a gross distortion to say that the claims on appeal are directed essentially to calculations. In *Flook,* by contrast, the claims recited nothing but the calculation, coupled with the post-solution activity consisting only of updating an alarm limit to the newly-calculated value which is merely a new number. Here, the calculation is intimately entwined with the rubber molding process recited. Therefore appellants are not claiming a process for merely generating a new number by calculation." (Petitioner's Appendix A, p. 17a, 602 F.2d at 989).

The CCPA also gave careful consideration to *Gottschalk v. Benson,* 409 U.S. 63, 93 S. Ct. 253, 34 L.ed.2d 273, 175 USPQ 673 (1972), considering it at length early in its opinion and later in connection with *Parker v. Flook.*

The CCPA noted that both *Flook* and *Benson* reject the notion that computer programs are *per se* unpatentable. For example, *Gottschalk v. Benson* states "It is said that the decision precludes a patent for any program servicing a computer. We do not so hold." (409 U.S. at 71). Basically, *Gottschalk v. Benson* held that algorithms *per se* are not patentable and that a process which is purely

mathematical is not patentable because it does not fall within section 101. In the Court's own words:

> "It is conceded that one may not patent an idea. But in practical effect that would be the result if the formula for converting BCD numerals to pure binary numerals were patented in this case. The mathematical formula involved here has no substantial practical application except in connection with a digital computer, which means that if the judgment below is affirmed, the patent would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself." (409 U.S. at 63, 175 USPQ at 676)

Parker v. Flook says, "Yet it is equally clear that a process is not unpatentable simply because it contains a law of nature or a mathematical algorithm. See *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 U.S. 45; *Tilghman v. Proctor*, 102 U.S. 707" (437 U.S. at 590, 98 S. Ct. at 2526). The Court added: "Mackay Radio[5] and Funk Bros.[6] point to the proper analysis for this case: The process itself, not merely the mathematical algorithm, must be new and useful." (Idem.)

In the present case, the chemical-mechanical process is new and useful, but the "algorithm" is the very old Arrhenius equation, which continues to remain in the public domain for all to use. Thus, the present claims describe a process that is clearly patentable under both *Flook* and *Benson*; the CCPA's decision is completely consistent with those cases and follows their rules.

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[5]*Mackay Radio & Telegraph Co. v. Radio Corporation of America*, 306 U.S. 86, 40 USPQ 199 (1939).

[6]*Funk Bros. Seed Co. v. Kalo Co.*, 333 U.S. 127, 76 USPQ 280 (1948).

The present chemical-mechanical process starts with uncured rubber and ends with a precisely cured precision-molded product. Heretofore, rubber molds were kept closed for too short a period or for too long, so that the products were usually either undercured or overcured. The present technological invention provides for completely accurate cure, so that no time is wasted in overcure, and up to 25% more production is achieved with exactly the same molds. Rejection rates were formerly high; now they are virtually zero.

The present process utilizes a computer, as one of several tools, to perform the necessary repetitive calculations as one step of the process to determine accurate cure time. The computer is used in conjunction with instruments for reading the actual mold temperature every few seconds. Heretofore, the Patent and Trademark Office has granted patents on such technology, even when using computers. Examples include the two patents appearing in the Petition, Appendices F and G.[7] The Gould et al. patent 3,718,721 was granted in 1973, and the Davis et al. patent 3,649,729 was granted in 1972; both patents disclose calculating cure time with computers and each lists the same equation, in a somewhat different form, as that used herein.

The CCPA has conscientiously followed this Court's decisions in patent cases involving computer-related claims and technology. Respondents have endeavored to survey cases involving computer-related claims and technology which have come before the CCPA, and have come up with

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[7]These patents are not in the record of this case, and their citation at this time as prior art to be considered is most improper. Appendices F and G should be stricken.

the following results (as of January 9, 1980). Thirty-six cases concerning computers were analyzed, which represented all computer CCPA patent cases in which the Supreme Court had no part. Of these, the scope of patentable subject matter under 35 U.S.C. § 101 was considered in fourteen reported cases, not counting the present case or the *Bradley* case, infra. The applicable Supreme Court decisions were considered in every single one of those opinions.[8] Seven decisions affirmed the Board,[9] while seven reversed.[10] A review of those opinions reveals the great pains which the judges of the court below have used in analyzing and applying the appropriate cases and principles. The CCPA has steadfastly defended the Supreme Court decisions from seriously flawed misinterpretations advocated by the Board and Petitioner. As the court held

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[8]Some of those opinions were issued before Flook was decided, and therefore it was not cited therein.

[9]Cases affirming Board rejections and applying Flook and/or Benson:

In re Maucorps, 609 F.2d 481, 203 USPQ 812 (CCPA 1979);
In re Gelnovatch, 595 F.2d 32, 201 USPQ 136 (CCPA 1979);
In re Sarkar, 588 F.2d 1330, 200 USPQ 132 (CCPA 1979);
In re Richman, 563 F.2d 1026, 195 USPQ 340 (CCPA 1977);
In re de Castelet, 562 F.2d 1236, 195 USPQ 439 (CCPA 1977);
In re Waldbaum, 559 F.2d 611, 194 USPQ 465 (CCPA 1977);
In re Christensen, 478 F.2d 1392, 178 USPQ 35 (CCPA 1973).

[10]Cases reversing Board rejections and applying Flook and/or Benson:

In re Phillips, 608 F.2d 879, 203 USPQ 971 (CCPA 1979);
In re Johnson, 589 F.2d 1070, 200 USPQ 199 (CCPA 1978);
In re Toma, 575 F.2d 872, 197 USPQ 852 (CCPA 1978);
In re Freeman, 573 F.2d 1237, 197 USPQ 464 (CCPA 1978);
In re Deutsch, 553 F.2d 689, 193 USPQ 645 (CCPA 1977);
In re Chatfield, 545 F.2d 152, 191 USPQ 730 (CCPA 1976) cert. denied, 434 U.S. 875 (1978);
In re Noll, 545 F.2d 141, 191 USPQ 721 (CCPA 1976) cert. denied, 434 U.S. 875 (1978).

in *In re Johnson*, 589 F.2d 1070, 1081, 200 USPQ 199, 210 (CCPA 1978):

> "There is no reason for the Solicitor or the PTO to shortcut the analytical framework set forth in *Benson, Flook*, and decisions of this Court by relying on *unfounded generalities.*" (emphasis added.)

3. A Patent Claim Drawn to Subject Matter That is Otherwise Patentable Under § 101 Does Not Become Unstatutory Merely Because a Computer Is Involved

This Court has so far attached no special significance to the presence or absence of a "computer." It *has* found significance in whether an applicant is attempting to patent a "law of nature" or a "mathematical algorithm." For example, in the *Mackay Radio* case, the *Eibel* case and *Tilghman v. Proctor*, all referred to with approval in *Parker v. Flook*, it was held that the mere presence of a law of nature or a mathematical algorithm does not render an otherwise patentable process claim unpatentable. Respondents submit, as was found by the CCPA below,[11] that the presence of a "computer" is no more significant than the presence of an algorithm or a law of nature. Thousands of patents have been issued on the basis of such cases as *Mackay* and *Eibel* and *Tilghman v. Proctor*, all *supra*, including two patents that Petitioner includes in Appendices F and G to his Petition. In fact, all patentable

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[11] ". . . we do not find either the presence or absence of computer-related recitations in a claim to be of any significance. If the claim is drawn to a mathematical algorithm, formula, or method of calculation, it is nonstatutory whether it recites that a computer, an abacus, or a pencil and paper are used to make the calculations. The statutory nature of a process or method does not depend, under § 101, on the means used to carry it out." (Petition Appendix A, p. 14a, 602 F.2d at 987)

inventions are in accord with laws of nature, whether or not the claims specifically state the law or laws.

Respondents' recitation of the old and well-known Arrhenius equation does not remove the equation from the public domain or make this case different from those earlier cases reciting the same equation where patents were issued. In *Parker v. Flook* it was admitted that the equation was the *sole* basis for the argument of patentability, but in the present case the chemical and mechanical process steps are relied on for patentability of each claim considered as a whole. The CCPA correctly held that the claimed process is a "process" under Section 101, *whether or not* an equation or a computer or both are involved:

> "A claim drawn to a process or method does not depend for its validity under 35 U.S.C. § 101 on whether a computer is involved. If the claim is drawn to subject matter, *which is otherwise statutory,* it does not become non-statutory merely because a computer is involved in its execution. Thus, the fact that it may be said that an invention is drawn to a computer program or involves a computer is an observation which does nothing to aid in the determination of compliance with § 101." (Petition Appendix A, p.7a, 602 F.2d at 985 (CCPA 1979)) (emphasis in original).

Section 101 specifically includes the term "process," and in *Gottschalk v. Benson* this Court stated:

> "Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines" (409 U.S. at 70, 175 USPQ at 676).

Here, the new process certainly transforms a crude mass of uncured synthetic elastomer into a precision-

molded and cured product. Hence, the process is patentable. Moreover, such a process is not rendered unpatentable by its use of any particular machine, including a computer.

4. Considerations of Novelty and Obviousness Do Not Bear on Section 101

The statutory classes of invention named in 35 U.S.C. § 101 set forth the categories of inventions which may be patented, provided that they meet the other standards in the patent law. Section 101 is a threshold determination that in no way depends on novelty (35 U.S.C. § 102) or unobviousness (35 U.S.C. § 103). The CCPA said in its opinion below:

> "Considerations of novelty and obviousness have no bearing on compliance with § 101. Thus, the fact that certain limitations in a claim may be novel and certain others may be old is irrelevant to the outcome of this case." (Petition, Appendix A, p.13a, 602 F.2d at 987) (citations omitted).[12]

Each claim must be considered as a whole, but the Patent and Trademark Office failed to do so in considering the application at issue. The CCPA below correctly noted this additional error:

> "The PTO has separated the claim into old and new elements, ignoring the presence of the old elements in its analysis. Such reasoning is impermissible. The novelty or otherwise of any element or even of all the

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[12]The issues of novelty and of unobviousness are not before the Court. The Examiner did consider them and decided them in Respondents' favor. They are not in the record considered by the CCPA since they were not material to the § 101 issue. See also MPEP 707.07(g) "Piecemeal Examinations".

elements or steps, or of the combination has no bearing on whether the process is encompassed by § 101." (Ibid. at 16a and 988).

5. There Should Be No Consolidation With Diamond v. Bradley and Franklin

In its petition filed December 3, 1979 in *Diamond v. Bradley and Franklin*,[13] the Petitioner asked this Court to consider consolidating it for argument with this case. Such consolidation would confuse rather than clarify the issues.

The only common ground between these cases is that the Patent and Trademark Office improperly urges that the issue in both cases is whether computer programs can be patented under Section 101. Neither case actually raises that issue.

The cases have *very* little in common. The present case claims a mechanical-chemical *process*, and the claims contain a mathematical formula. The issue is whether claims to an otherwise statutory process become non-statutory claims merely because of the presence of a mathematical formula or merely because a computer is used in part of the process. *Bradley and Franklin* involves a *machine or apparatus*, specifically a computer; no mathematical formula is claimed or implied.

Even if certiorari be granted in both cases, the two cases are too different for *consolidation* of argument. Respondents therefore request that consolidation be denied.

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[13]The case below is *In re Bradley and Franklin*, 600 F.2d 807, 202 USPQ 480 (CCPA 1979).

CONCLUSION

The CCPA fully considered both the issues and the pertinent Supreme Court decisions, *Parker v. Flook* and *Gottschalk v. Benson.* It has properly applied those decisions to the issues, and correctly decided the case.

The Supreme Court's decisions in *Mackay Radio, Eibel,* and *Tilghman v. Proctor* are controlling; there is no conflict between those cases and *Flook* or *Benson.*

The *actual* issues at bar are run-of-the-mill. Nevertheless, the Patent and Trademark Office apparently wants to have this Court find otherwise and address questions which are not raised by the present case. Having made no attempt to claim a mathematical calculation, a computer program, or anything like one, Respondents seek to protect a process for precision molding of rubber. That process clearly lies within § 101, whether or not it uses a computer.

Respondents respectfully urge that the Petition for Certiorari be denied.

Respectfully submitted,

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